

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

SUN OPTICS INC.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 07-137-SLR
)	
FGX INTERNATIONAL INC.,)	
)	
Defendant.)	

AFFIRMATION OF DONALD J. DETWEILER

DONALD J. DETWEILER, an attorney duly admitted to practice in the courts of the State of Delaware, affirms the following under the penalties of perjury:

1. I am a member of the law firm of Greenberg Traurig, LLP, counsel for Defendant FGX International, Inc. ("FGX"). I make this Affirmation in support of FGX's motion to dismiss the Complaint in this Action.

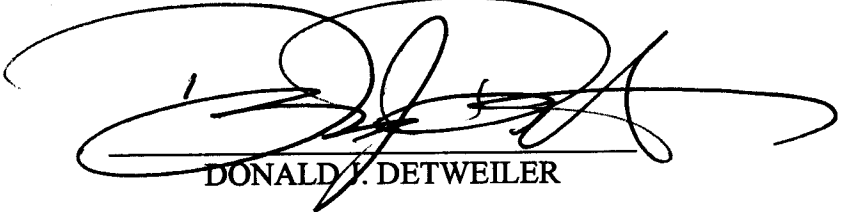
2. Attached hereto as Exhibit A is a true and correct copy of the Complaint in this matter, dated March 7, 2007.

3. Attached hereto as Exhibit B is a true and correct copy of Plaintiff's Utah Complaint, dated February 28, 2007, Sun Optics, Inc. v. FGX International, Case No. 2:07-cv-00121 (BSJ) (the "Utah Action").

4. Attached hereto as Exhibit C is a true and correct copy of the docket sheet for Plaintiff's Utah Action.

5. Attached hereto as Exhibit D is a true and correct copy of select pages from Patent Application 29/221,502 and Patent Application 29/205,824 submitted to the U.S. Patent and Trademark Office, on June 2, 2006.

Dated: Wilmington, Delaware
April __, 2007



DONALD J. DETWEILER

Exhibit A

**UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF DELAWARE**

SUN OPTICS, INC.
a Utah Corporation,

Plaintiff,

v.

FGX INTERNATIONAL, INC.,
a Delaware Corporation,

Defendant.

Civil Action No. _____

JURY TRIAL DEMANDED

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Sun Optics, Inc. ("Sun Optics") complains against Defendant FGX International, Inc. ("Foster Grant") and for a cause of action alleges as follows:

JURISDICTION AND VENUE

1. Sun Optics is a Utah corporation having a principal place of business at 1785 South 4490 West, Salt Lake City, Utah, 84104, Salt Lake City County, and does business in this judicial district.

2. Upon information and belief, Foster Grant is a Delaware corporation having its principal place of business at 500 George Washington Highway, Smithfield, Rhode Island 02917.

3. This is a civil action brought by Sun Optics for patent infringement committed by defendant Foster Grant and arising under the patent laws of the United States, more specifically, under Title 35 U.S.C. §§ 271, 281, 283, 284, and 285. Jurisdiction of this court is founded upon 28 U.S.C. §§ 1331 and 1338(a).

4. Upon information and belief, defendant Foster Grant has transacted business, contracted to supply goods or services and has otherwise purposely availed itself of the

privileges and benefits of the laws of the state of Delaware, including, but not limited to, the offer for sale of infringing products within the state of Delaware, and therefore is subject to the jurisdiction of this Court pursuant to 10 Del. C. § 3104.

5. Venue is proper in this district pursuant to 28 U.S.C. §§ 1400(b) and 1391.

BACKGROUND

6. Sun Optics designs and sells innovative reading glasses, reading glass cases, and displays for merchandising reading glasses. Foster Grant is a direct competitor of Sun Optics, and also sells reading glasses and reading glass cases.

7. Sun Optics has created an entire merchandising program, called the Clear Tube program, based on certain designs of innovative reading glass cases that allow consumers to view the glasses inside the cases. Two such innovative designs are the subject of U.S. Patent Nos. D525,427 and D527,180 (the "'427 patent" and "'180 patent" respectively).

8. Sun Optics's Clear Tube program has been extremely successful. Indeed, Sun Optics marketed the Clear Tube program to the national chain of Rite Aid stores, which was a Foster Grant customer at the time. Apparently impressed by the Clear Tube program, Rite Aid took approximately 25% of the shelf space it had previously granted to Foster Grant, and awarded that space to Sun Optics.

9. In approximately the later part of 2006, Foster Grant launched a new line of reading glasses sold in reading glass cases identical to the designs claimed in the '427 and '180 patents in all material respects.

FIRST CLAIM FOR RELIEF INFRINGEMENT OF THE '427 PATENT BY FOSTER GRANT

10. Sun Optics hereby incorporates the allegations of paragraphs 1-9 of this Complaint into the First Claim for Relief as though fully set forth herein.

11. Sun Optics is the owner by assignment of U.S. Patent No. D525,427. A true and correct copy of the '427 patent is attached hereto as Exhibit A.

12. The '427 patent is directed to an ornamental design for a reading glass case.

13. The '427 patent was duly and validly issued by the United States Patent and Trademark Office after having been examined according to law.

14. Foster Grant has sold and/or offered to sell products falling within the scope of the claim of the '427 patent without license or authority from Sun Optics in violation of Sun Optics's rights, thereby directly infringing the '427 patent. Such infringing products include, but are not limited to, products sold under the trade names "Private Eyes" and "Sun Reader." Pictures of the products offered for sale by Foster Grant that are accused of infringing the '427 patent are attached hereto as Exhibit B.

15. Upon information and belief, Foster Grant is aware of the existence of the '427 patent and despite such knowledge continues to willfully, wantonly and deliberately engage in acts of infringement, as that term is defined in 35 U.S.C. § 271, without regard to the '427 patent, and will continue to do so unless otherwise enjoined by this Court.

16. Sun Optics has been and will continue to be damaged by the infringing conduct of defendant Foster Grant, in an amount to be established upon proper proof at trial.

17. Sun Optics is suffering irreparable harm due to Foster Grant's infringement of the '427 patent, and will continue to be irreparably harmed unless and until defendant Foster Grant is enjoined from future infringement.

**SECOND CLAIM FOR RELIEF
INFRINGEMENT OF THE '180 PATENT
BY FOSTER GRANT**

18. Sun Optics hereby incorporates the allegations of paragraphs 1-17 of this Complaint into the Second Claim for Relief as though fully set forth herein.

19. Sun Optics is the owner by assignment of U.S. Patent No. D527,180. A true and correct copy of the '180 patent is attached hereto as Exhibit C.

20. The '180 patent is directed to an ornamental design for a reading glass case.

21. The '180 patent was duly and validly issued by the United States Patent and Trademark Office after having been examined according to law.

22. Foster Grant has sold and/or offered to sell products falling within the scope of the claim of the '180 patent without license or authority from Sun Optics in violation of Sun Optics's rights, thereby directly infringing the '180 patent. Such infringing products include, but are not limited to, products sold under the trade names "Private Eyes" and "Comfort Flex." Pictures of the products offered by Foster Grant that are accused of infringing the '180 patent are attached hereto as Exhibit D.

23. Upon information and belief, Foster Grant is aware of the existence of the '180 patent and despite such knowledge continues to willfully, wantonly and deliberately engage in acts of infringement, as that term is defined in 35 U.S.C. § 271, without regard to the '180 patent, and will continue to do so unless otherwise enjoined by this Court.

24. Sun Optics has been and will continue to be damaged by the infringing conduct of defendant Foster Grant, in an amount to be established upon proper proof at trial.

25. Sun Optics is suffering irreparable harm due to Foster Grant's infringement of the '180 patent, and will continue to be irreparably harmed unless and until defendant Foster Grant is enjoined from future infringement.

PRAYER FOR RELIEF

WHEREFORE, Sun Optics prays for judgment against Foster Grant as follows:

A. For judgment holding defendant Foster Grant liable for infringement of the '429 and '180 patents;

B. For an award of damages adequate to compensate Sun Optics for the infringement of the '429 and '180 patents by Foster Grant, including treble damages, costs and all other categories of damages allowed by 35 U.S.C. § 284;

C. For preliminary and permanent injunctive relief enjoining defendant Foster Grant, its officers, agents, servants, employees and attorneys and all other persons in active concert or participation with them as follows:

- (i) from using, manufacturing, offering to sell or selling any products falling within the scope of the claim of the '429 and '180 patents;
- (ii) from importing any product into the United States which falls within the scope of the '429 and '180 patents;
- (iii) from actively inducing others to infringe any of the claims of the '429 and '180 patents;
- (iv) from engaging in acts constituting contributory infringement of any of the claims of the '429 and '180 patents;
- (v) from all other acts of infringement of any of the claims of the '429 and '180 patents;

D. That this be declared an exceptional case and that Sun Optics be awarded its attorney fees against defendant Foster Grant pursuant to 35 U.S.C. § 285;

G. For such further relief as this Court deems Sun Optics may be entitled to in law and in equity.

JURY TRIAL DEMAND

Sun Optics hereby demands a trial by jury of all issues in this action so triable.

Respectfully submitted

CONNOLLY BOVE LODGE & HUTZ, LLP

By:


R. ERIC HUTZ (#2702)
The Nemours Building
1007 N. Orange Street
P.O. Box 2207
Wilmington, DE 19899
Phone (302) 658-9141
ehutz@cblh.com
Attorneys for Plaintiff
SUN OPTICS, INC, Inc.

LARRY R. LAYCOCK
CHAD E. NYDEGGER
WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
Telephone: (801) 533-9800
Attorneys for Plaintiff
SUN OPTICS, INC.

DATE: March 7, 2007

525586_1

EXHIBIT A



US00D525427S

(12) **United States Design Patent** (10) Patent No.: **US D525,427 S**
Raile (45) Date of Patent: **Jul. 25, 2006**

(54) **EYEGLASS CASE**(75) Inventor: **Bruce Raile, Park City, UT (US)**(73) Assignee: **Sun Optics, Inc., Salt Lake City, UT (US)**

(*) Notice: This patent is subject to a terminal disclaimer.

(**) Term: **14 Years**(21) Appl. No.: **29/205,824**(22) Filed: **May 20, 2004**(51) LOC (8) Cl. **03-01**(52) U.S. Cl. **D3/265; D3/263**(58) Field of Classification Search **D3/263, D3/265, 268; 206/5, 6, 203.5; 351/63; 220/326**
See application file for complete search history.(56) **References Cited****U.S. PATENT DOCUMENTS**

246,460 A * 8/1881 Chase 206/6
1,092,156 A 4/1914 Mathis
2,606,708 A 8/1952 Irvan
2,713,947 A 7/1955 Foster
2,735,597 A 2/1956 Treleven
2,747,760 A 5/1956 Jacobson
2,809,786 A * 10/1957 Anderson 220/326
2,816,666 A 12/1957 Nadel
RE24,571 E 11/1958 Nadel
2,936,897 A 5/1960 Bloch
2,966,271 A 12/1960 Nadel
3,333,709 A 8/1967 Leblanc et al.
D208,469 S 9/1967 Parker
3,357,568 A 12/1967 Leblanc et al.
3,593,856 A 7/1971 Zander
3,817,392 A 6/1974 Bloch
3,857,482 A 12/1974 Shelton
3,866,800 A 2/1975 Schmitt
4,000,810 A 1/1977 Leblanc
4,204,602 A 5/1980 Dunchock
D267,992 S 2/1983 Shelton
D275,160 S 8/1984 Shelton

D275,161 S 8/1984 Shelton
4,572,366 A 2/1986 Carson
4,614,272 A 9/1986 Shelton et al.
D286,462 S * 11/1986 Sender et al. D3/265
4,715,575 A 12/1987 Kameron
4,733,775 A 3/1988 Fireman
4,744,461 A 5/1988 Lapham
5,141,117 A 8/1992 Olsen et al.
D339,913 S * 10/1993 Reed D3/265
5,423,419 A 6/1995 Wentz et al.
5,501,321 A 3/1996 Liu
D369,466 S 5/1996 Jannard et al.
5,568,872 A 10/1996 Hinnant, Sr.
D400,009 S * 10/1998 Conway D3/265
5,899,371 A * 5/1999 Weliver 224/245
5,929,967 A 7/1999 Conner

(Continued)

FOREIGN PATENT DOCUMENTS

DE 3815889 11/1989

Primary Examiner—Celia A. Murphy

(74) Attorney, Agent, or Firm—Workman-Nydegger

(57) **CLAIM**

The ornamental design for an eyeglass case, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of an eyeglass case showing my new design;

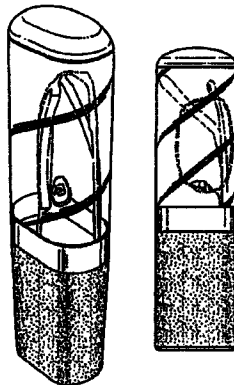
FIG. 2 is a front elevational view of the eyeglass case as shown in FIG. 1, with the back elevational view being a mirror image thereof;

FIG. 3 is a right side elevational view of the eyeglass case shown in FIG. 1, with the left side being a mirror image thereof;

FIG. 4 is a top plan view of an eyeglass case shown in FIG. 1; and,

FIG. 5 is a bottom plan view of the eyeglass case as shown in FIG. 1.

The broken lines are for illustrative purposes only and form no part of the claimed design.

1 Claim, 2 Drawing Sheets

US D525,427 S

Page 2

U.S. PATENT DOCUMENTS

5,949,515 A	9/1999	Hoshino		6,273,246 B1 *	8/2001	Marciano	206/301
D422,139 S *	4/2000	Meikle	D3/268	D454,686 S *	3/2002	McCormack	D3/265
D425,299 S *	5/2000	Charbonneau	D3/265	6,382,407 B1 *	5/2002	Chao	206/5
6,102,541 A *	8/2000	Kuo	351/63	6,415,915 B1	7/2002	Grossman	
D432,784 S *	10/2000	Conway	D3/203.5	D467,421 S *	12/2002	Chao	D3/265
D432,786 S *	10/2000	Rogers	D3/265	6,491,158 B1 *	12/2002	Chen	206/5
D434,560 S *	12/2000	Chao	D3/265	6,626,287 B1	9/2003	Watson	
D436,434 S *	1/2001	Conway	D3/203.5	D483,944 S *	12/2003	Conner	D3/265
D436,725 S *	1/2001	Rogers	D3/265	6,789,664 B1	9/2004	Chao	
6,170,651 B1 *	1/2001	Tsormina	206/5	6,851,552 B1 *	2/2005	Chao	206/5
D437,112 S *	2/2001	Toffoli	D3/219	6,929,116 B1 *	8/2005	Chao et al.	206/5
6,206,217 B1 *	3/2001	Chiang	220/8	2002/0157968 A1 *	10/2002	Chen	206/5
D439,738 S *	4/2001	McCormack	D3/265	2003/0111361 A1	6/2003	Fischer et al.	
D441,953 S *	5/2001	Ben Moshe	D3/265	2005/0155872 A1 *	7/2005	Cheng	206/6
D446,389 S *	8/2001	Zhou	D3/265				

* cited by examiner

U.S. Patent

Jul. 25, 2006

Sheet 1 of 2

US D525,427 S

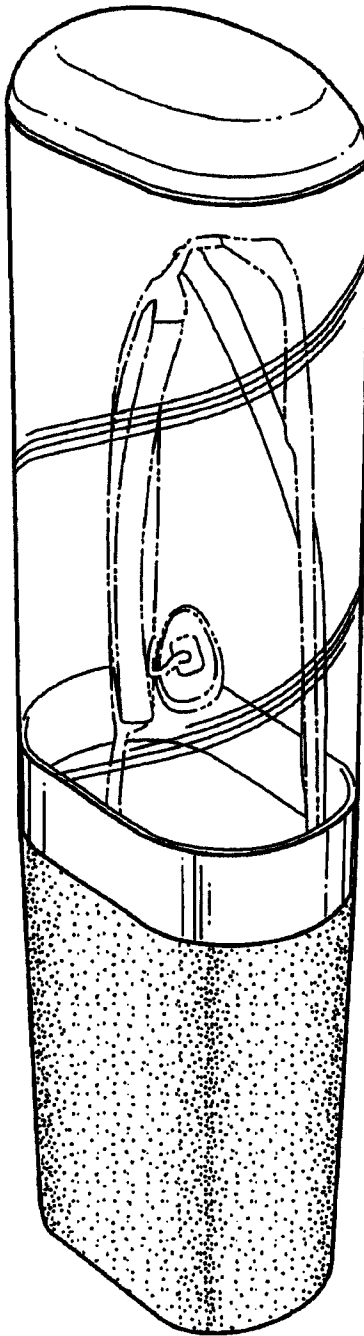


Fig. 1

U.S. Patent

Jul. 25, 2006

Sheet 2 of 2

US D525,427 S

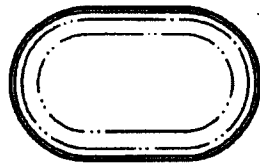


Fig. 4

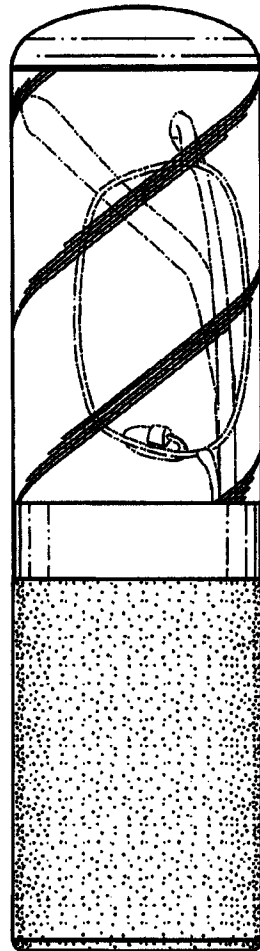


Fig. 2



Fig. 3

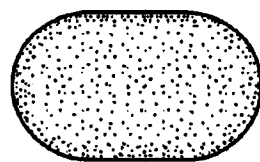


Fig. 5

EXHIBIT B



EXHIBIT C



US00D527180S

(12) **United States Design Patent** (10) Patent No.: **US D527,180 S**
Raile (45) Date of Patent: **** Aug. 29, 2006**

(54) **EYEGLASS CASE**(75) Inventor: **Bruce Raile, Park City, UT (US)**(73) Assignee: **Sun Optics, Inc., Salt Lake City, UT (US)**(*) Notice: **This patent is subject to a terminal disclaimer.**(**) Term: **14 Years**(21) Appl. No.: **29/221,502**(22) Filed: **Jan. 17, 2005****Related U.S. Application Data**

(63) Continuation of application No. 29/205,824, filed on May 20, 2004.

(51) LOC (8) Cl. 03-01

(52) U.S. Cl. D3/265; D3/263

(58) Field of Classification Search D3/263, D3/265, 268; 206/5, 6, 203.5; 351/63; 220/326
See application file for complete search history.(56) **References Cited****U.S. PATENT DOCUMENTS**

246,460 A * 8/1881 Chase 206/6
1,092,156 A 4/1914 Mathis
2,606,708 A 8/1952 Irvan
2,713,947 A 7/1955 Foster
2,735,597 A 2/1956 Treleven
2,747,760 A 5/1956 Jacobson
2,809,766 A * 10/1957 Anderson 220/326
2,816,666 A 12/1957 Nadel
RE24,571 E 11/1958 Nadel
2,936,897 A 5/1960 Bloch
2,966,271 A 12/1960 Nadel
3,333,709 A 8/1967 Leblanc et al.
D208,469 S 9/1967 Parker
3,357,568 A 12/1967 Leblanc et al.
3,593,856 A 7/1971 Zander
3,817,392 A 6/1974 Bloch
3,857,482 A 12/1974 Shelton

3,866,800 A 2/1975 Schmitt
4,000,810 A 1/1977 Leblanc
4,204,602 A 5/1980 Dunchock
D267,992 S 2/1983 Shelton
D275,160 S 8/1984 Shelton
D275,161 S 8/1984 Shelton
4,572,366 A 2/1986 Carson
4,614,272 A 9/1986 Shelton et al.
D286,462 S * 11/1986 Sender et al. D3/265
4,715,575 A 12/1987 Kameron
4,733,775 A 3/1988 Fireman
4,744,461 A 5/1988 Lapham
5,141,117 A 8/1992 Olsen et al.
D339,913 S * 10/1993 Reed D3/265
5,423,419 A 6/1995 Wentz et al.
5,501,321 A 3/1996 Liu

(Continued)

FOREIGN PATENT DOCUMENTS

DE 3815889 11/1989

Primary Examiner—Celia A. Murphy

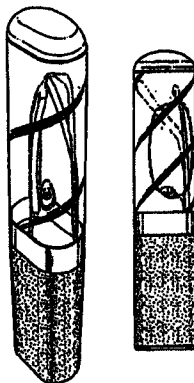
(74) Attorney, Agent, or Firm—Workman-Nydegger

(57) **CLAIM**

The ornamental design for an eyeglass case, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of an eyeglass case showing my new design;
FIG. 2 is a front elevational view of the eyeglass case as shown in FIG. 1, with the back elevational view being a mirror image thereof;
FIG. 3 is a right side elevational view of the eyeglass case shown in FIG. 1, with the left side view being a mirror image thereof;
FIG. 4 is a top plan view of the eyeglass case shown in FIG. 1; and,
FIG. 5 is a bottom plan view of the eyeglass case as shown in FIG. 1.
The broken lines are for illustrative purposes only and form no part of the claimed design.

1 Claim, 2 Drawing Sheets

US D527,180 S

Page 2

U.S. PATENT DOCUMENTS

D369,466 S	5/1996	Jannard et al.		D439,738 S	*	4/2001	McCormack	D3/265	
5,568,872 A	10/1996	Hinnant, Sr.		D441,953 S	*	5/2001	Ben Moshe	D3/265	
D400,009 S	*	10/1998	Conway	D446,389 S	*	8/2001	Zhou	D3/265
5,899,371 A	*	5/1999	Weliver	6,273,246 B1	*	8/2001	Marciano	206/301
5,929,967 A		7/1999	Conner		D454,686 S	*	3/2002	McCormack	D3/265
5,949,515 A		9/1999	Hoshino		6,382,407 B1	*	5/2002	Chao	206/5
D422,139 S	*	4/2000	Meikle	6,415,915 B1		7/2002	Grossman		
D425,299 S	*	5/2000	Charbonneau	D467,421 S	*	12/2002	Chao	D3/265
6,102,541 A	*	8/2000	Kuo	6,491,158 B1	*	12/2002	Chen	206/5
D432,784 S	*	10/2000	Conway	6,626,287 B1		9/2003	Watson		
D432,786 S	*	10/2000	Rogers	D483,944 S	*	12/2003	Conner	D3/265
D434,560 S	*	12/2000	Chao	6,789,664 B1		9/2004	Chao		
D436,434 S	*	1/2001	Conway	6,851,552 B1	*	2/2005	Chao	206/5
D436,725 S	*	1/2001	Rogers	6,929,116 B1	*	8/2005	Chao et al.	206/5
6,170,651 B1	*	1/2001	Taormina	2002/0157968 A1	*	10/2002	Chen	206/5
D437,112 S	*	2/2001	Toffoli	2003/0111361 A1		6/2003	Fischer et al.		
6,206,217 B1	*	3/2001	Chiang	2005/0155872 A1	*	7/2005	Cheng	206/6

* cited by examiner

U.S. Patent

Aug. 29, 2006

Sheet 1 of 2

US D527,180 S

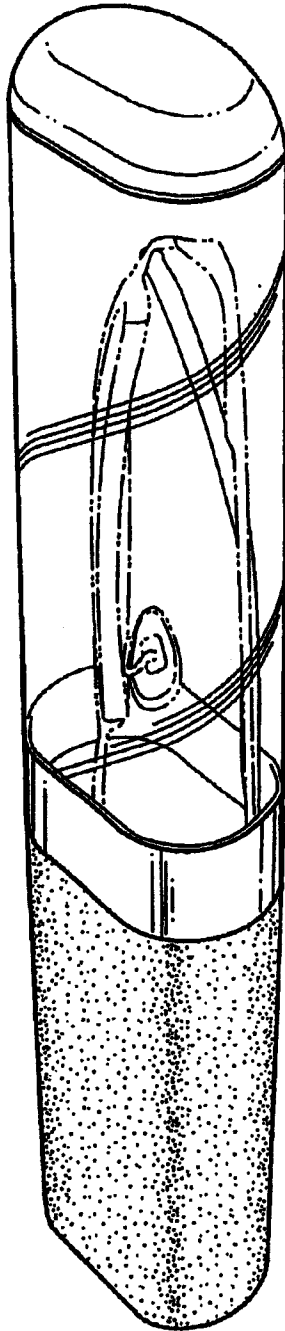


Fig. 1

U.S. Patent

Aug. 29, 2006

Sheet 2 of 2

US D527,180 S



Fig. 4

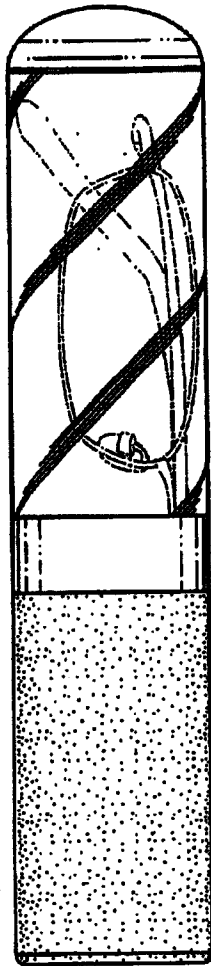


Fig. 2



Fig. 3

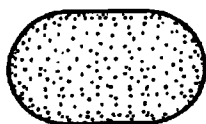
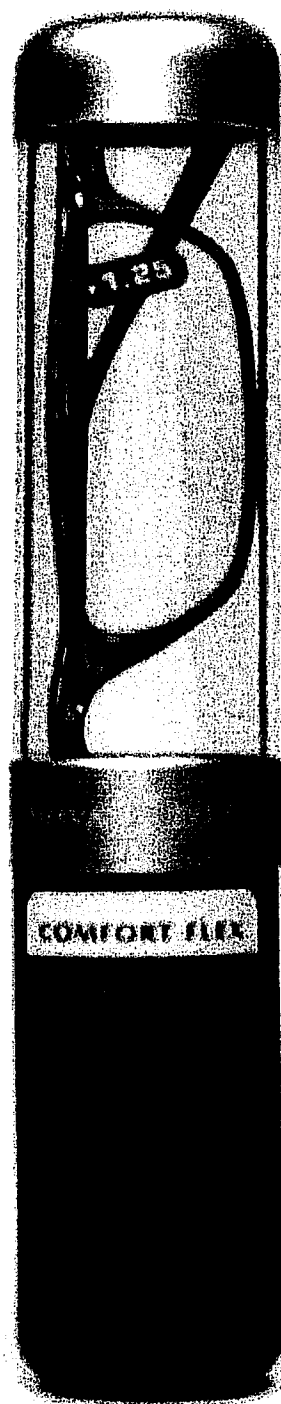


Fig. 5

EXHIBIT D



JS 44 (Rev. 11/04)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

SUN OPTICS, INC.

(b) County Of Residence Of First Listed Plaintiff Salt Lake City County
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) ATTORNEYS (FIRM NAME, ADDRESS AND TELEPHONE NUMBER)

R. Eric Hutz, Esquire (#2702)
CONNOLLY BOVE LODGE & HUTZ, LLP
1007 N. Orange Street, P.O. Box 2207
Wilmington, Delaware 19899

Telephone: (302) 658-9141

DEFENDANTS

FGX INTERNATIONAL, INC

County Of Residence Of First Listed Defendant: New Castle County
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

ATTORNEYS (IF KNOWN)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff ☒ 3 Federal Question
(U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant ☐ 4 Diversity
(Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business in Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 480 Commerce <input type="checkbox"/> 480 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 880 Securities/ Commodities/ Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/ Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	<input type="checkbox"/> 510 Motions to Vacate Sentence HABEAS CORPUS: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt Relations <input type="checkbox"/> 730 Labor/Mgmt Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1385f) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS - Third Party 26 USC 7609

V. ORIGIN (PLACE AN "X" IN ONE BOX ONLY)

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from another district (specify) ☐ 6 Multidistrict Litigation ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
38 U.S.C. §271 (a) through (c)

Brief description of cause:
Patent Infringement

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND:
In excess of \$75,000

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ YES ☐ NO

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

March 7, 2007

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

R. Eric Hutz

INSTRUCTIONS FOR ATTORNEYS COMPLETING CIVIL COVER SHEET FORM JS-44**Authority For Civil Cover Sheet**

The JS-44 civil cover sheet and the information contained herein neither replaces nor supplements the filings and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. Consequently, a civil cover sheet is submitted to the Clerk of Court for each civil complaint filed. The attorney filing a case should complete the form as follows:

I. (a) **Plaintiffs - Defendants.** Enter names (last, first, middle initial) of plaintiff and defendant. If the plaintiff or defendant is a government agency, use only the full name or standard abbreviations. If the plaintiff or defendant is an official within a government agency, identify first the agency and then the official, giving both name and title.

(b) **County of Residence.** For each civil case filed, except U.S. plaintiff cases, enter the name of the county where the first listed plaintiff resides at the time of filing. In U.S. plaintiff cases, enter the name of the county in which the first listed defendant resides at the time of filing. (NOTE: In land condemnation cases, the county of residence of the "defendant" is the location of the tract of land involved.)

(c) **Attorneys.** Enter the firm name, address, telephone number, and attorney of record. If there are several attorneys, list them on an attachment, noting in this section "(see attachment)".

II. **Jurisdiction.** The basis of jurisdiction is set forth under Rule 8(a), F.R.C.P., which requires that jurisdictions be shown in pleadings. Place an "X" in one of the boxes. If there is more than one basis of jurisdiction, precedence is given in the order shown below.

United States plaintiff. (1) Jurisdiction based on 28 U.S.C. 1345 and 1348. Suits by agencies and officers of the United States are included here.

United States defendant. (2) When the plaintiff is suing the United States, its officers or agencies, place an "X" in this box.

Federal question. (3) This refers to suits under 28 U.S.C. 1331, where jurisdiction arises under the Constitution of the United States, an amendment to the Constitution, an act of Congress or a treaty of the United States. In cases where the U.S. is a party, the U.S. plaintiff or defendant code takes precedence, and box 1 or 2 should be marked.

Diversity of citizenship. (4) This refers to suits under 28 U.S.C. 1332, where parties are citizens of different states. When Box 4 is checked, the citizenship of the different parties must be checked. (See Section III below: federal question actions take precedence over diversity cases.)

III. **Residence (citizenship) of Principal Parties.** This section of the JS 44 is to be completed if diversity of citizenship was indicated above. Mark this section for each principal party.

IV. **Nature of Suit.** Place an "X" in the appropriate box. If the nature of suit cannot be determined, be sure the cause of action, in Section VI below, is sufficient to enable the deputy clerk or the statistical clerks in the Administrative Office to determine the nature of suit. If the cause fits more than one nature of suit, select the most definitive.

V. **Origin.** Place an "X" in one of the seven boxes.

Original Proceedings. (1) Cases which originate in the United States district courts.

Removed from State Court. (2) Proceedings initiated in state courts may be removed to the district courts under Title 28 U.S.C. Section 1441. When the petition for removal is granted, check this box.

Remanded from Appellate Court. (3) Check this box for cases remanded to the district court for further action. Use the date of remand as the filing date.

Reinstated or Reopened. (4) Check this box for cases reinstated or reopened in the district court. Use the reopening date as the filing date.

Transferred from Another District. (5) For cases transferred under Title 28 U.S.C. Section 1404(a). Do not use this for within district transfers or multidistrict litigation transfers.

Multidistrict Litigation. (6) Check this box when a multidistrict case is transferred into the district under authority of Title 28 U.S.C. Section 1407. When this box is checked, do not check (5) above.

Appeal to District Judge from Magistrate Judgment. (7) Check this box for an appeal from a magistrate judge's decision.

VI. **Cause of Action.** Report the civil statute directly related to the cause of action and give a brief description of the cause. Do not cite jurisdictional statutes unless diversity. Example: U.S. Civil Statute: 47 USC 553

Brief Description: Unauthorized reception of cable service.

VII. **Requested in Complaint.** Class Action. Place an "X" in this box if you are filing a class action under Rule 23, F.R.Cv.P.

Demand. In this space enter the dollar amount (in thousands of dollars) being demanded or indicate other demand such as a preliminary injunction.

Jury Demand. Check the appropriate box to indicate whether or not a jury is being demanded.

VIII. **Related Cases.** This section of the JS 44 is used to reference related pending cases if any. If there are related pending cases, insert the docket numbers and the corresponding judge names for such cases.

Date and Attorney Signature. Date and sign the civil cover sheet.

AO FORM 85 RECEIPT (REV. 9/04)

United States District Court for the District of Delaware

07 - 137

Civil Action No. _____

FILED
U.S. DISTRICT COURT
DISTRICT OF DELAWARE
2007 MAR -7 PM 4:35

ACKNOWLEDGMENT
OF RECEIPT FOR AO FORM 85

NOTICE OF AVAILABILITY OF A
UNITED STATES MAGISTRATE JUDGE
TO EXERCISE JURISDICTION

I HEREBY ACKNOWLEDGE RECEIPT OF 2 COPIES OF AO FORM 85.

(Date forms issued)


(Signature of Party or their Representative)

Dustin Frohlich
(Printed name of Party or their Representative)

Note: Completed receipt will be filed in the Civil Action

Exhibit B

FILED
U.S. DISTRICT COURT

2007 FEB 28 A 11:44

DISTRICT OF UTAH

BY: _____
ERK

LARRY R. LAYCOCK (USB No. 4868)
CHAD E. NYDEGGER (USB No. 9964)
WORKMAN NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

Attorneys for Plaintiff
SUN OPTICS, INC.

Judge Bruce S. Jenkins
DECK TYPE: Civil
DATE STAMP: 02/28/2007 @ 11:43:32
CASE NUMBER: 2:07CV00121 BSJ

UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF UTAH - CENTRAL DIVISION

SUN OPTICS, INC. a Utah Corporation,
Plaintiff,

v.

FGX INTERNATIONAL, INC., a Delaware
Corporation,
Defendant.

Civil action No. _____

**COMPLAINT FOR PATENT
INFRINGEMENT**

JURY TRIAL DEMANDED

Plaintiff Sun Optics, Inc. ("Sun Optics") complains against Defendant FGX International, Inc. ("Foster Grant") and for a cause of action alleges as follows:

JURISDICTION AND VENUE

1. Sun Optics is a Utah corporation having a principal place of business at 1785 South 4490 West, Salt Lake City, Utah 84104 and does business in this judicial district.

2. Upon information and belief, Foster Grant is a Delaware corporation having its principal place of business at 500 George Washington Highway, Smithfield, Rhode Island 02917.

3. This is a civil action brought by Sun Optics for patent infringement committed by defendant Foster Grant and arising under the patent laws of the United States, more specifically,

under Title 35 U.S.C. §§ 271, 281, 283, 284, and 285. Jurisdiction of this court is founded upon 28 U.S.C. §§ 1331 and 1338(a).

4. Upon information and belief, defendant Foster Grant has transacted business, contracted to supply goods or services and has otherwise purposely availed itself of the privileges and benefits of the laws of the state of Utah, including, but not limited to, the offer for sale of infringing products within the state of Utah, and therefore is subject to the jurisdiction of this Court pursuant to U.C.A. § 78-27-24.

5. Venue is proper in this district pursuant to 28 U.S.C. §§ 1400(b) and 1391.

BACKGROUND

6. Sun Optics designs and sells innovative reading glasses, reading glass cases, and displays for merchandising reading glasses. Foster Grant is a direct competitor of Sun Optics, and also sells reading glasses and reading glass cases.

7. Sun Optics has created an entire merchandising program, called the Clear Tube program, based on certain designs of innovative reading glass cases that allow consumers to view the glasses inside the cases. Two such innovative designs are the subject of U.S. Patent Nos. D525,427 and D527,180 (the “’427 patent” and “’180 patent” respectively).

8. Sun Optics’s Clear Tube program has been extremely successful. Indeed, Sun Optics marketed the Clear Tube program to the national chain of Rite Aid stores, which was a Foster Grant customer at the time. Apparently impressed by the Clear Tube program, Rite Aid took approximately 25% of the shelf space it had previously granted to Foster Grant, and awarded that space to Sun Optics.

9. In approximately the later part of 2006, Foster Grant launched a new line of reading glasses sold in reading glass cases identical to the designs claimed in the ’427 and ’180 patents in all material respects.

**FIRST CLAIM FOR RELIEF
INFRINGEMENT OF THE '427 PATENT
BY FOSTER GRANT**

10. Sun Optics hereby incorporates the allegations of paragraphs 1-9 of this Complaint into the First Claim for Relief as though fully set forth herein.

11. Sun Optics is the owner by assignment of U.S. Patent No. D525,427. A true and correct copy of the '427 patent is attached hereto as Exhibit A.

12. The '427 patent is directed to an ornamental design for a reading glass case.

13. The '427 patent was duly and validly issued by the United States Patent and Trademark Office after having been examined according to law.

14. Foster Grant has sold and/or offered to sell products falling within the scope of the claim of the '427 patent without license or authority from Sun Optics in violation of Sun Optics's rights, thereby directly infringing the '427 patent. Such infringing products include, but are not limited to, products sold under the trade names "Private Eyes" and "Sun Reader." Pictures of the products offered for sale by Foster Grant that are accused of infringing the '427 patent are attached hereto as Exhibit B.

15. Upon information and belief, Foster Grant is aware of the existence of the '427 patent and despite such knowledge continues to willfully, wantonly and deliberately engage in acts of infringement, as that term is defined in 35 U.S.C. § 271, without regard to the '427 patent, and will continue to do so unless otherwise enjoined by this Court.

16. Sun Optics has been and will continue to be damaged by the infringing conduct of defendant Foster Grant, in an amount to be established upon proper proof at trial.

17. Sun Optics is suffering irreparable harm due to Foster Grant's infringement of the '427 patent, and will continue to be irreparably harmed unless and until defendant Foster Grant is enjoined from future infringement.

**SECOND CLAIM FOR RELIEF
INFRINGEMENT OF THE '180 PATENT
BY FOSTER GRANT**

18. Sun Optics hereby incorporates the allegations of paragraphs 1-17 of this Complaint into the Second Claim for Relief as though fully set forth herein.

19. Sun Optics is the owner by assignment of U.S. Patent No. D527,180. A true and correct copy of the '180 patent is attached hereto as Exhibit C.

20. The '180 patent is directed to an ornamental design for a reading glass case.

21. The '180 patent was duly and validly issued by the United States Patent and Trademark Office after having been examined according to law.

22. Foster Grant has sold and/or offered to sell products falling within the scope of the claim of the '180 patent without license or authority from Sun Optics in violation of Sun Optics's rights, thereby directly infringing the '180 patent. Such infringing products include, but are not limited to, products sold under the trade names "Private Eyes" and "Comfort Flex." Pictures of the products offered by Foster Grant that are accused of infringing the '180 patent are attached hereto as Exhibit D.

23. Upon information and belief, Foster Grant is aware of the existence of the '180 patent and despite such knowledge continues to willfully, wantonly and deliberately engage in acts of infringement, as that term is defined in 35 U.S.C. § 271, without regard to the '180 patent, and will continue to do so unless otherwise enjoined by this Court.

24. Sun Optics has been and will continue to be damaged by the infringing conduct of defendant Foster Grant, in an amount to be established upon proper proof at trial.

25. Sun Optics is suffering irreparable harm due to Foster Grant's infringement of the '180 patent, and will continue to be irreparably harmed unless and until defendant Foster Grant is enjoined from future infringement.

**THIRD CLAIM FOR RELIEF
VIOLATION OF THE UTAH UNFAIR COMPETITION ACT
UTAH CODE § 13-5A-101 et seq.**

26. Sun Optics hereby incorporates the allegations of paragraphs 1-25 of this Complaint into the Third Claim for Relief as though fully set forth herein.

27. Foster Grant's business act or practice of marketing products that infringe the '427 and '180 patents is unlawful, unfair, and fraudulent.

28. This unlawful, unfair, and fraudulent business act or practice by Foster Grant leads to a material diminution in value of Sun Optics's intellectual property in the '427 and '180 patents.

29. Foster Grant has infringed and continues to infringe the '427 and '180 patents, as set forth above.

PRAYER FOR RELIEF

WHEREFORE, Sun Optics prays for judgment against Foster Grant as follows:

A. For judgment holding defendant Foster Grant liable for infringement of the '429 and '180 patents;

B. For an award of damages adequate to compensate Sun Optics for the infringement of the '429 and '180 patents by Foster Grant, including treble damages and all other categories of damages allowed by 35 U.S.C. § 284;

C. For preliminary and permanent injunctive relief enjoining defendant Foster Grant, its officers, agents, servants, employees and attorneys and all other persons in active concert or participation with them as follows:

- (i) from using, manufacturing, offering to sell or selling any products falling within the scope of the claim of the '429 and '180 patents;
- (ii) from importing any product into the United States which falls within the scope of the '429 and '180 patents;

- (iii) from actively inducing others to infringe any of the claims of the '429 and '180 patents;
- (iv) from engaging in acts constituting contributory infringement of any of the claims of the '429 and '180 patents;
- (v) from all other acts of infringement of any of the claims of the '429 and '180 patents;

D. That this be declared an exceptional case and that Sun Optics be awarded its attorney fees against defendant Foster Grant pursuant to 35 U.S.C. § 285;

E. For an award of damages, costs, attorney fees, and punitive damages pursuant to Utah Code § 13-5a-103;

F. For an award of Sun Optics's costs of this action; and


G. For such further relief as this Court deems Sun Optics may be entitled to in law and in equity.

JURY TRIAL DEMAND

Sun Optics hereby demands a trial by jury of all issues in this action so triable.

Respectfully submitted this 28th day of February, 2007.

WORKMAN NYDEGGER


LARRY R. LAYCOCK
CHAD E. NYDEGGER

Attorneys for Plaintiff
Sun Optics, Inc.

Address of Plaintiff:
1785 South 4490 West
Salt Lake City, Utah 84104

Exhibit C

CLOSED, PATENT

**Electronic Case Filing System
 District of Utah (Central)
 CIVIL DOCKET FOR CASE #: 2:07-cv-00121-BSJ**

Sun Optics v. FGX International
 Assigned to: Judge Bruce S. Jenkins
 Cause: 35:0271 Patent Infringement

Date Filed: 02/28/2007
 Date Terminated: 03/12/2007
 Jury Demand: Plaintiff
 Nature of Suit: 830 Patent
 Jurisdiction: Federal Question

Plaintiff

Sun Optics
a Utah Corporation

represented by **Chad E. Nydegger**
 WORKMAN NYDEGGER
 1000 EAGLE GATE TOWER
 60 E SOUTH TEMPLE
 SALT LAKE CITY, UT 84111
 (801)533-9800
 Email: cnydegger@wnlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Larry R. Laycock
 WORKMAN NYDEGGER
 1000 EAGLE GATE TOWER
 60 E SOUTH TEMPLE
 SALT LAKE CITY, UT 84111
 (801)533-9800
 Email: orders@wnlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

V.

Defendant

FGX International
a Delaware Corporation

Date Filed	#	Docket Text
02/28/2007	<u>1</u>	COMPLAINT against FGX International (Filing fee \$ 350, receipt number 4681016461), filed by Sun Optics. (Attachments: # <u>1</u> Exhibit A - Copy of US Patent D525,427# <u>2</u> Exhibit B - Pictures of products violating '427 patent# <u>3</u> Exhibit C - Copy of US Patent D527,180# <u>4</u> Exhibit D - Pictures of Products Violating '180 Patent# <u>5</u> Civil Cover Sheet) Assigned to Judge Bruce S. Jenkins (jwt) (Entered: 02/28/2007)
02/28/2007	<u>2</u>	MOTION for Preliminary Injunction filed by Plaintiff Sun Optics. (jwt) (Entered: 02/28/2007)

02/28/2007	<u>3</u>	MEMORANDUM in Support re <u>2</u> MOTION for Preliminary Injunction filed by Plaintiff Sun Optics. (jwt) (Entered: 02/28/2007)
02/28/2007	<u>4</u>	DECLARATION of Bruce Raile re <u>2</u> MOTION for Preliminary Injunction filed by Sun Optics. (jwt) (Entered: 02/28/2007)
02/28/2007	<u>5</u>	Report on the Filing of an action sent to the Director of the U.S. Patent and Trademark Office. (jwt) (Entered: 02/28/2007)
03/07/2007	<u>6</u>	NOTICE of Voluntary Dismissal filed by Plaintiff Sun Optics (Nydegger, Chad) (Entered: 03/07/2007)
03/12/2007	<u>7</u>	ORDER DISMISSING CASE - Case Closed. Signed by Judge Bruce S. Jenkins on 3/12/07. (jwt) (Entered: 03/12/2007)

PACER Service Center			
Transaction Receipt			
04/02/2007 12:35:54			
PACER Login:	gt1218	Client Code:	083557.072900
Description:	Docket Report	Search Criteria:	2:07-cv-00121-BSJ
Billable Pages:	1	Cost:	0.08

Exhibit D

06-05-05



PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 or **Fax** (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

022913 7590 03/22/2006

WORKMAN NYDEGGER
 (F/K/A WORKMAN NYDEGGER & SEELEY)
 60 EAST SOUTH TEMPLE
 1000 EAGLE GATE TOWER
 SALT LAKE CITY, UT 84111

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/221,502	01/17/2005	Bruce Raile	14301.50	6681

TITLE OF INVENTION: EYEGLOSS CASE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$400	\$0	\$400	06/22/2006

EXAMINER	ART UNIT	CLASS-SUBCLASS
MURPHY, CELIA A	2916	D03-265000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, use 2006 TBSHARE 00000070 29221502

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Workman-Nydegger 45.00 UP
 2 45.00 UP
 3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Sun Optics, Inc.

Salt Lake City, Utah

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☒ Advance Order - # of Copies 15

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
☒ Payment by credit card. Form PTO-2038 is attached.
☒ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 23-3178 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

John C. Stringham

Date June 2, 2006

Typed or printed name

John C. Stringham

Registration No. 40,831

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Notice of Allowability

Application No.

29/221,502

Examiner

Celia A. Murphy

Applicant(s)

RAILE, BRUCE

Art Unit

2916

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendments and terminal disclaimer filed on 2/2/2006.
2. ☒ The allowed claim(s) is/are the single ornamental claim.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 (a) ☐ Including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
 Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>11/15/05 & 2/2/06</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Application/Control Number: 29/221,502

Page 2

Art Unit: 2916

An examiner's amendment to the record appears below. If applicant wishes to make further changes and/or additions, then he may file an amendment.¹ To ensure the examiner's consideration, the amendment **MUST** be submitted before payment of the issue fee.

The examiner has carefully reviewed the applicant's terminal disclaimer, amendment, and remarks, dated 2/02/2006.

Applicant's amendments include claims to priority that do not meet the requirements for continuity. The claimed design shown in Serial No. 29/205,824 is acknowledged, however, applicant has not claimed "*continuity*" to the application.

The following amendment to the specification **has superseded, (replaced)** all of the amendments regarding the *claim to priority* in this application. In the original specification, the first paragraph has been amended to:

-- **This application is a continuation of US Design Application, Serial No. 29/205824 filed on May 20, 2004, which is incorporated herein by reference.**

The applicant's most recent amendment improperly claims the benefit of priority to another co-pending case, 10/360,264. This additional copending case, 10/360,264, does *not* disclose the same subject matter as the claimed design according to 35 USC 112.

The claim to priority in the amendment filed on 2/20/2006, beginning with, "*Please replace Paragraph [001]...*" and ending with "*...incorporated herein by reference.*" has been cancelled.

Applicant's terminal disclaimer is approved.

C. A. Murphy
March 20, 2006


CELINA A. MURPHY
PRIMARY EXAMINER
GROUP ART UNIT 2914

¹ As provided for by 37 CFR 1.312



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/221,502	01/17/2005	Bruce Raile	14301.50	6681
22913	7590	11/18/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			MURPHY, CELIA A	
			ART UNIT	PAPER NUMBER
			2916	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	29/221,502	RAILE, BRUCE	
	Examiner	Art Unit	
	Celia A. Murphy	2916	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ The claim is pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ The claim is rejected.
- 7) ☒ Claim(s) to priority is/are objected to.
- 8) ☐ The claim is subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/17/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | filed: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| filed: <u>04/03/05</u> <u>06/05</u> | 6) <input type="checkbox"/> Other: _____ |

Application/Control Number: 29/221,502

Page 2

Art Unit: 2916

The preliminary amendment claiming priority to a provisional application is objected to. No claim for priority based on a provisional application may be made in a design application.¹ ***Applicant should cancel his claim to priority.***

For clarity, the descriptions of Fig. 1 should be amended to read:

-- **Figure 1 is a perspective view of an EYEGLASS CASE showing my new design;** --

The claim is provisionally rejected under the judicially created doctrine of obviousness-type double patenting of the claim of copending Application No. 29/205,824.

Although the conflicting claims are not identical, they are not patentably distinct from each other because to simply increase or decrease the proportion of the design would be obvious to a person of ordinary skill in the art. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability.²

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.³

The references are cited as possible pertinent art.

The claim stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

Questions about this communication should be directed to examiner, C. A.

¹ MPEP 1.53 (c) (4)

² See *In re Frick*, 275 F.2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

³ See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Application/Control Number: 29/221,502

Page 3

Art Unit: 2916

Murphy, whose telephone number is (571) 272-2654. If attempts to reach the examiner by telephone are unsuccessful, then the examiner's supervisor, I. Simmons can be reached at (571) 272-2658. The Central FAX phone number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Contact the Electronic Business Center, (EBC) toll-free, at 866-217-9197 for answers to questions about access to the Private PAIR system.

Questions about clerical processing of should be directed to Vonda Gale, the Supervisory applications Examiner, whose telephone number is (571) 272-2578.

**C. A. Murphy
November 4, 2005**


**CELIA MURPHY
PRIMARY EXAMINER
ART UNIT 2914**

06-05-06

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or **Fax** (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

022913 7590 03/22/2006

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111



Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/205,824	05/20/2004	Bruce Raile	14301.44	9949

TITLE OF INVENTION: EYEGLOSS CASE

06/06/2006 NGBREH2 0000053 29205824

01 FC:2502

02 FC:0001

APPLN. TYPE	SMALL ENTITY STATUS	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$400	\$0	\$400	06/22/2006

EXAMINER	ART UNIT	CLASS-SUBCLASS
MURPHY, CELIA A	2916	D03-265000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Workman-Nydegger

2

3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Sun Optics, Inc.

Salt Lake City, Utah

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☒ Advance Order - # of Copies 15

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
☒ Payment by credit card. Form PTO-2038 is attached.
☒ The Director is hereby authorized by check the required fee(s), or credit any overpayment, to Deposit Account Number 23-3178 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

Date June 2, 2006

Typed or printed name

John C. Stringham

Registration No. 40,831

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Notice of Allowability	Application No.	Applicant(s)	
	29/205,824	RAILE, BRUCE	
	Examiner	Art Unit	
	Celia A. Murphy	2916	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendments and terminal disclaimer filed on 2/2/2006.
2. ☒ The allowed claim(s) is/are the single ornamental claim.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>11/15/05 & 2/2/06</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Application/Control Number: 29/205,824

Page 2

Art Unit: 2916

An examiner's amendment to the record appears below. If applicant wishes to make further changes and/or additions, then he may file an amendment.¹ To ensure the examiner's consideration, the amendment **MUST** be submitted before payment of the issue fee.

The examiner has carefully reviewed the applicant's terminal disclaimer, amendment, and remarks, dated 2/02/2006.

Although applicant's amendment cancels claim to priority from the *provisional* application, there remains a claim to priority that does not meet the requirement for continuity. Copending application, Serial Number, 10/360,264, does not disclose the claimed design according to 35 USC 112. Further, continuity is not specifically claimed in this application.

In light of the above, **all statements claiming priority to Serial Number, 10/360,264 appearing in this application are improper, and have been cancelled.**

Applicant's terminal disclaimer is approved.

C. A. Murphy
March 20, 2006


CELIA A. MURPHY
PRIMARY EXAMINER
GROUP ART UNIT 2914

¹ As provided for by 37 CFR 1.312



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1459
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
29/205,824	05/20/2004	Bruce Raile	14301.44	9949
22913	7590	11/18/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			MURPHY, CELIA A	
			ART UNIT	PAPER NUMBER
			2916	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	29/205,824	RAILE, BRUCE	
	Examiner	Art Unit	
	Celia A. Murphy	2916	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ The claim is pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ The claim is rejected.
- 7) ☒ Claim(s) to priority is/are objected to.
- 8) ☐ The claim is subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | filed: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| filed: <u>9/16/2004</u> | 6) <input type="checkbox"/> Other: _____ |

Application/Control Number: 29/205,824

Page 2

Art Unit: 2916

The preliminary amendment claiming priority to a provisional application is objected to. No claim for priority based on a provisional application may be made in a design application.¹
Applicant should cancel his claim to priority.

For clarity, the descriptions of Fig. 1 should be amended to read:

-- **Figure 1 is a perspective view of an EYEGLASS CASE showing my new design; --**

The claim is provisionally rejected under the judicially created doctrine of obviousness-type double patenting of the claim of copending Application No. 29/221,502.

Although the conflicting claims are not identical, they are not patentably distinct from each other because to simply increase or decrease the proportion of the design would be obvious to a person of ordinary skill in the art. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability.²

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.³

The references are cited as possible pertinent art.

The claim stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

Questions about this communication should be directed to examiner, C. A.

¹ MPEP 1.53 (c) (4)

² See *In re Frick*, 275 F.2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

³ See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Application/Control Number: 29/205,824

Page 3

Art Unit: 2916

Murphy, whose telephone number is (571) 272-2654. If attempts to reach the examiner by telephone are unsuccessful, then the examiner's supervisor, I. Simmons can be reached at (571) 272-2658. The Central FAX phone number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Contact the Electronic Business Center, (EBC) toll-free, at 866-217-9197 for answers to questions about access to the Private PAIR system.

Questions about clerical processing of should be directed to Vonda Gale, the Supervisory applications Examiner, whose telephone number is (571) 272-2578.

**C. A. Murphy
November 4, 2005**


**CELIA MURPHY
PRIMARY EXAMINER
ART UNIT 2914**